**Listing of the Claims:**

This listing of claims will replace all prior versions, and listings, of claims in the application:

**Amendments to the Claims:**

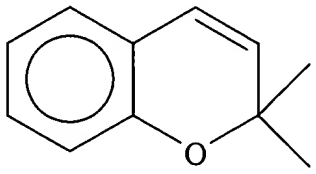
Claims 1-23 (cancelled).

Claim 24. (previously presented): A method for preparing a latex with photochromic properties comprising:

preparing an aqueous emulsion (I) of a composition A comprising:

at least one organic monomer Z, wherein said at least one monomer is further defined as comprising a C=C group and being capable of free-radical polymerization, and

one or more organic photochromic compounds containing a nucleus of formula:




; and

polymerizing composition A in the presence of a water-soluble initiator to obtain particles of an at least partially polymerized latex with photochromic properties.

Claim 25. (previously presented): The method of claim 24, wherein composition A comprises only one type of organic monomer Z.

Claim 26. (previously presented): The method of claim 24, wherein composition a comprises more than one type of organic polymer Z.

Claim 27. (previously presented): The method of claim 24, wherein the latex is a fully polymerized latex.

Claim 28. (previously presented): The method of claim 24, wherein the latex is a partially polymerized latex.

Claim 29. (previously presented): The method of claim 28, further defined as comprising:

adding to the at least partially polymerized latex a second aqueous emulsion (II) containing a composition B comprising at least one organic monomer capable of free-radical polymerization; and

polymerizing composition to obtain a latex comprising at least biphasic photochromic particles.

Claim 30. (previously presented): The method of claim 29, wherein the biphasic latex is further defined as comprising a core/skin structure.

Claim 31. (previously presented): The method of claim 24, wherein the water-soluble initiator is introduced progressively to the aqueous emulsion I, during the polymerization.

Claim 32. (previously presented): The method of claim 24, wherein the water-soluble initiator and the aqueous emulsion (I) are each introduced progressively into a reaction medium throughout polymerization.

Claim 33. (previously presented): The method of claim 24, wherein the water-soluble initiator is an alkali or ammonium persulfate.

Claim 34. (previously presented): The method of claim 33, wherein the water-soluble initiator is potassium or sodium persulfate.

Claim 35. (previously presented): The method of claim 24, wherein the percentage by weight of the initiator with respect to total organic weight of monomer or monomers capable of free-radical polymerization used for the preparation of the latex is between 0.1 and 1%.

Claim 36. (previously presented): The method of claim 24, wherein the organic monomer Z is an alkyl (meth)acrylate monomer.

Claim 37. (previously presented): The method of claim 24, wherein composition A is further defined as comprising at least one monomer Z which is further defined as a low Tg monomer which leads to a homopolymer whose glass transition temperature is less than or equal to 0°C.

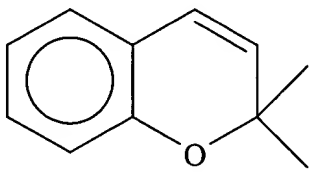
Claim 38. (previously presented): The method of claim 37, wherein the low Tg monomer represents at least 40% by weight of the monomers capable of free-radical polymerization.

Claim 39. (previously presented): The method of claim 24, wherein the particles of the latex are further defined as having a diameter of 50 to 400 nm.

Claim 40. (previously presented): The method of claim 24, wherein a dry extract of the latex represents from 30 to 50% of the total weight of the latex.

Claim 41. (previously presented): The method of claim 24, wherein the pH of the latex is between 5 and 7.

Claim 42. (previously presented): A latex with photochromic properties, further defined as comprising particles of a polymer material resulting from the free-radical polymerization of at least one monomer Z with a C=C group comprising one or more organic photochromic compound comprising a nucleus of formula:

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the particles of said polymer material having an average size of between 50 and 400 nm.

Claim 43. (previously presented): The latex of claim 42, wherein the particles are further defined as having an average size of between 80 and 300 nm.

Claim 44. (previously presented): The latex of claim 43, wherein the particles are further defined as having an average size between 150 and 250 nm.

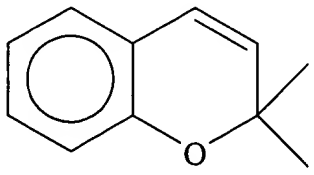
Claim 45. (previously presented): The latex of claim 42, wherein the organic photochromic compound is further defined as not containing an indoline ring.

Claim 46. (currently amended): The latex of claim 45, wherein the particles of polymer material have a biphasic structure[[~~, preferably~~]] of the core/skin type.

Claim 47. (previously presented): The latex of claim 46, wherein the organic photochromic compound is contained in the core of the particles.

Claim 48. (previously presented): The latex of claim 42, wherein a dry extract of the latex represents from 30 to 50% of the total weight of the latex.

Claim 49. (previously presented): A substrate comprising a dry latex film with photochromic properties, the latex further defined as comprising particles of a polymer material resulting from the free-radical polymerization of at least one monomer Z with a C=C group comprising one or more organic photochromic compound comprising a nucleus of formula:

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the particles of said polymer material having an average size of between 50 and 400 nm.

Claim 50. (previously presented): The substrate of claim 49, wherein the film has a thickness of between 3 and 20 μm.

Claim 51. (previously presented): The substrate of claim 49, further defined as comprising an anti-abrasion coating.

Claim 52. (previously presented): The substrate of claim 49, further defined as comprising an anti-reflection coating.

Claim 53. (previously presented): The substrate of claim 49, further defined as comprising an anti-abrasion coating on the latex film and an anti-reflection coating on the anti-abrasion coating.

Claim 54. (previously presented): The substrate of claim 49, further defined as an ophthalmic lens.

Claim 55. (previously presented): The method of claim 39, wherein the particles of the latex are further defined as having an average size of between 80 and 300 nm.

Claim 56. (previously presented): The method of claim 55, wherein the particles are further defined as having an average size between 150 and 250 nm.

Claim 57. (previously presented): The method of claim 24, wherein the organic photochromic compound is further defined as not containing an indoline ring.

Claim 58. (currently amended): The method of claim 57, wherein the particles of polymer material have a biphasic structure[[~~, preferably~~]] of the core/skin type.

Claim 59. (previously presented): The method of claim 58, wherein the organic photochromic compound is contained in the core of the particles.

Claim 60. (previously presented): The method of claim 24, wherein the latex is further defined as a dry latex film.

Claim 61. (previously presented): The method of claim 60, wherein the dry latex film has a thickness of between 3 and 20 $\mu$m.

Claim 62. (previously presented): The method of claim 24, wherein a substrate comprises the latex.

Claim 63. (previously presented): The method of claim 62, wherein the substrate further comprises an anti-abrasion coating.

Claim 64. (previously presented): The method of claim 62, wherein the substrate further comprises an anti-reflection coating.

Claim 65. (previously presented): The method of claim 62, wherein the substrate comprises an anti-abrasion coating on the latex film and an anti-reflection coating on the anti-abrasion coating.

Claim 66. (previously presented): The method of claim 62, wherein the substrate is further defined as an ophthalmic lens.

**A Response to the Office Action Dated January 7, 2004:**

**A. Status of the Claims**

Claims 23-66 were pending upon the issuance of the Action dated January 7, 2004. Claims 46 and 58 have been amended to further conform these claims to U.S. prosecution standards. In view of the fact that these amendments relate only to the correction of non-substantive matters, they do not in any way affect the scope of the claims or range of equivalents that the elements in the claims are entitled. Claims 23-66, therefore, are currently pending.

**B. The Submission of the Foreign Priority Document**

The previous Office Action dated April 9, 2003 notes that the U.S. Patent and Trademark Office has not yet received a certified copy of the priority document (French Application No. 99/02437 filed on 26 February 1999) for this case. Applicant submits a certified copy the French Application with this Response.

**C. The Anticipation Rejection is Improper**

**1. A Summary of the Rejection and the Standard for Establishing Anticipation**

The Action rejects claims 42-54 under 35 U.S.C. § 102(b) as being anticipated by JP 10-25471 ("JP '471"). The Action contends that JP '471 discloses a photochromic latex that includes a napthopyran compound formed by using an initiator and a monomer, wherein a biphasic layer is formed. The Action admits, however, that this reference does not disclose the size of the latex particles. *See* the Action, page 2. To supplement the deficient teachings, the Action contends that the JP '471 reference "would inherently have the same latex particle size as the present invention." *Id.* at page 1.

Applicants traverse. Claims 42-54 are not anticipated by JP '471 either expressly or inherently.

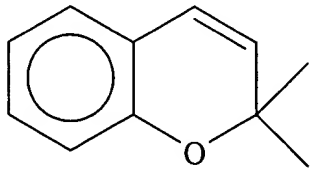
### 2. The Standard for Anticipation by Inherency

Anticipation requires that each and every element of the claimed invention be described, either expressly or inherently, in a single prior art reference. *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1327, 58 U.S.P.Q.2d 1545, 1552 (Fed. Cir. 2001); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Examiner and only if that burden is met, does the burden of going forward shift to the applicant. *See In re Sun*, 31 U.S.P.Q.2d 1451 (Fed. Cir. 1993).

With respect to anticipation by inherency, inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1994). Moreover, the Federal Circuit has repeatedly stated that "the extrinsic evidence must make clear that the missing descriptive matter is ***necessarily present*** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Telemac Cellular Corp. v. Topp Telecom, Inc.* 247 F.3d 1316, 1328 (Fed. Cir. 2001) (emphasis added); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Continental Can Co. v. Monsanto Co.*, 948 F.3d 1264, 1268 (Fed. Cir. 1994) (emphasis added). In fact, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic ***necessarily flows*** from the teachings of the applied prior art." *In re Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Interferences 1990) (citing *In re King*, 231 U.S.P.Q. 136 (Fed. Cir. 1986))(emphasis added); *see also Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Interferences 1986).

### 3. The Present Invention

Applicants presently claim "[a] latex with photochromic properties, further defined as comprising particles of a polymer material resulting from the free-radical polymerization of at least one monomer Z with a C=C group comprising one or more organic photochromic compound comprising a nucleus of formula:

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the particles of said polymer material having ***an average size of between 50 and 400 nm***." Claim 42 (emphasis added). Applicants also claim a corresponding "substrate comprising a dry latex film." Claim 49.

As discussed in detail in the following section, JP '471 does not inherently teach Applicants' claimed invention. The Action has not met its initial burden of establishing anticipation by inherency. Moreover, the Action has failed to establish that the latex particle sizes in JP '471 have "an average size of between 50 and 400 nm."

### 4. A *Prima Facie* Case of Anticipation By Inherency Has Not Been Established

The Action admits that the JP '471 reference fails to teach particles "having an average size of between 50 and 400 nm." The Action, page 3. The Action's assertion that the particles of JP '471 would inherently have the same particle size of the present invention is incorrect. The Action has not cited to appropriate evidence to support such a contention. *See In re Sun*, 31 U.S.P.Q.2d 1451. The Examiner's evidence that JP '471 inherently discloses Applicants' claimed invention is the Examiner's own statement that:

> JP '471 teaches a photochromic latex which comprises naphthopyran compounds which is formed by using an initiator, such as persulfate, and monomers, such as methacrylates...Such would inherently have the same latex particle size as in the present invention.

The Action, page 1. In support of this statement, the Action improperly cites to a declaration (The Maisonnier Declaration) submitted in a non-related application (U.S. Application No. 09/991,773 (the '773 Application). Other that its improper citation to the Maisonnier Declaration, the Action fails to cite to any other references, to any particular passages in the '471 reference to support its inherency argument, or for that matter any evidence (extrinsic or intrinsic) to support the present rejection.

The Action's reliance on the Maisonnier Declaration is not evidence for anything in the present application and is improper for at least two reasons. First, the Maisonnier Declaration is not prior art to the present application. Second, the '773 application is not related to the present application and does not have the same inventive entity as the present application. Because the '773 application has a different inventive entity and, therefore, different Applicants than the present application, the Action's statement that "[s]ince ***applicants*** declaration has provided evidence that whichever method is used to form a typical latex, the particle size is within the scope of the present claims, a rejection under 35 U.S.C. 102 has been added" is legally inaccurate. Again, the Applicants in the '773 Application are ***different*** than the Applicants of the present application. The Action fails to provide any legal basis to support its reliance on evidence submitted by different applicants in an unrelated case to support the present inherency rejection.

The Action also fails to show that the allegedly inherent characteristic, *i.e.*, particles "having an average size of between 50 and 400 nm," "necessarily flows" from the teachings of JP '471—a necessary requirement to establish anticipation by inherency. *See In re Levy*, 17

U.S.P.Q.2d at 1464. As admitted by the Action, JP '471 does not disclose particle sizes. As for the Maisonnier Declaration, it was filed in a separate case with distinct claims. The Declaration does not address any of the teachings of the JP '471 reference, much less how the latexes disclosed in the JP '471 reference were formed or what size the particles would be. It does not necessarily flow, therefore, that Applicants' claimed particle size is inherently disclosed by the cited art.

This is further supported by U.S. Patent No. 4,489,108 ("the '108 patent") which is listed in the Action's own PTO-892 form (paper no. 7) that is attached to the previous Office Action dated April 9, 2003. The '108 patent discloses latexes that have particles sizes ***outside*** of the range of Applicants' claimed range. *See* the '108 patent, col. 5, lines 24-29 and lines 43-49 (disclosing particle sizes having an average size of 480 nm and 920 nm, respectively). It cannot be maintained, therefore, that a person of ordinary skill in the art would expect that the particle sizes in JP '471 would necessarily have an average size of between 50 and 400 nm. *See Continental Can Co.*, 948 F.2d at 1269 (noting that "[t]he mere fact that a certain thing ***may*** result from a given set of circumstances is not sufficient" to establish anticipation by inherency.) (emphasis added). Additionally, a person of ordinary skill in the art would not look to the Maisonnier Declaration for anything, much less for a determination on what size the particles would be in the JP '471 reference. The Declaration is ***not*** prior art; it is ***not*** available to people of ordinary skill in the art. *See Telemac Cellular Corp.*, 247 F.3d at 1328 (noting that "the extrinsic evidence must make clear that the missing descriptive matter is ***necessarily present*** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.").

If the Action is relying on personal knowledge or any other reference to support the proposition that particles within Applicants' claimed range are "necessarily present" in JP '471, Applicants must request that the Examiner prepare an affidavit and enter it into the file history of this application pursuant to 37 C.F.R. § 1.104(d)(2); *see also* MPEP § 2144.03(C).

With respect to present claim 46, which includes the additional element that "the particles of polymer material have a biphasic structure of the core/skin type," Applicant notes the JP '471 reference fails to teach this element, and consequently, fails to anticipate this claim. The Action has provided no evidence that the particles disclosed in JP '471 would include the subject matter of claim 46. Again, Applicants request that an affidavit be prepared if the Action is relying on personal knowledge to support such an assertion. *Id.*

Based on the lack of evidence and the deficient teachings of JP '471, the present anticipation rejection must fall. The rejection of claims 42-54 under 35 U.S.C. § 102(b) as being anticipated by JP '471 should therefore be withdrawn.

**D. The Obviousness Rejection is Improper**

**1. A Summary of the Rejection**

The Action also rejects claims 42-54 under 35 U.S.C. § 103(a) as being unpatentable over JP '471 in view of the Maisonnier Declaration and U.S. Patent 4,578,305 to Postle *et al.* As discussed above, the Action admits that the primary reference, JP '471, "differs from the present invention in that the size of the latex particles are not specifically disclosed." The Action, page 2.

To supplement the deficient teachings of JP '471, the Action improperly cites to the Maisonnier declaration—which is not prior art to the present claims—and states that "the teachings therein state that the typical latex formed by different methods of emulsion, still have a particle size of 150-250 nm." *Id.* at page 2. The Action also contends that Postle *et al.* discloses

"that variation of the particle size of the latex in a photochromic latex will have significant impact on films formed thereby." From this, the Action concludes that Applicants' claimed invention is obvious.

Applicants traverse this rejection. Claims 42-54 are not obvious over the cited references.

**2. The Maisonnier Declaration Is Not Prior Art**

The Action relies on the Maisonnier Declaration as a "prior art" reference in making its obviousness rejection. *See* the Action, page 2. This is improper because the Maisonnier Declaration is ***not*** prior art under U.S. patent law. The Declaration does not fall under any subsection of 35 U.S.C. § 102. Applicants have not adopted—nor even referred to—the Maisonnier Declaration. The present application is not related to the 09/991,773 application nor does it contain the same inventive entity. No admissions have been made by the Applicants in the present case that the Declaration is even applicable to the rejections presented in this case.

For at least these reasons, reliance by the Action on the Maisonnier Declaration is improper and without legal basis. Because the obviousness rejection is based on the Maisonnier Declaration, and because this Declaration is not "prior art" to the present claims, the obviousness rejection cannot be maintained.

The following sections provide additional support showing that the present obviousness rejection is improper. In summary, the Action has not provided the required amount of evidence to support a *prima facie* case of obviousness. Additionally, all three of the required elements for establishing a *prima facie* case of obviousness have not been shown by the Action.

**3. The Standard for Establishing a *Prima Facie* Case of Obviousness**

It is well settled that "[t]he examiner bears the initial burden of factually supporting any *prima facie* case of obviousness. If the examiner does not produce a *prima facie* case, the

applicant is under ***no*** obligation to submit evidence of non-obviousness." MPEP § 2142 (8th Ed. Rev. 1, 2003) (emphasis added).

To establish a *prima facie* case of obviousness, the Examiner must show: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) a reasonable expectation of success; and (3) the prior art reference teaches or suggests all of the claim limitations. MPEP § 2142; *see also In re Vaeck*, 947 F.2d 488. With respect to the motivation to combine the references, the MPEP states "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless ***the prior art also suggests the desirability*** of the combination." MPEP § 2143.01 (emphasis added). If any one of the three elements is missing, a *prima facie* case of obviousness cannot be established.

**4. The Action Has Not Presented Any Evidence to Support the Obviousness Rejection**

The Action has not presented the required evidence to support a *prima facie* case of obviousness. The Action admits that the primary reference relied upon to support the obviousness rejection, JP '471, "differs from the present invention in that the size of the latex particles are not specifically disclosed." The Action, page 2. The Action's attempt to combine the teaching of the JP '471 reference with the teachings of the Maisonnier Declaration and the Postle reference is improper. As discussed above and incorporated into this section by reference, the Action's reliance on a declaration submitted in an unrelated case with a different inventive entity is not prior art to the present case and is not evidence of obviousness in the present case.

Additionally, the Action failed to provide any evidence showing a motivation to combine the teachings of JP '471 with those of Postle *et al.* An unsubstantiated opinion that "it would be

obvious to one of ordinary skill in the art to vary the size of the latex particles in order to optimize the photochromic properties of the latex" does not rise to the level of evidence required to support the obviousness rejection. *See* MPEP § 2143.01 ([t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless ***the prior art also suggests the desirability*** of the combination." (emphasis added). The Action's citation to *In re Allen*, 103 U.S.P.Q. 233 and *In re Rose*, 103 U.S.P.Q. 237 is ***not*** evidence of obviousness nor is it evidence of a motivation to combine the cited references. The citation to these cases is used merely as legal theory to support its unsubstantiated arguments. Based on the lack of evidence alone, the present obviousness rejection must fall. *See* MPEP § 2142 ("The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under ***no obligation*** to submit evidence of nonobviousness") (emphasis added).

Because the required evidence necessary to support a *prima facie* case of obviousness has not been presented by the Action, the present obviousness rejection cannot be maintained. The present obviousness rejection should therefore be withdrawn.

**5. The Cited References Fail To Teach Every Element of the Present Invention**

A necessary requirement in establishing a *prima facie* case of obviousness mandates a showing by the Action that every element is taught or suggested by the cited references. This has not been done. Applicants' arguments discussed in addressing the anticipation inherency rejection above, are incorporated into this section by reference. Based on these arguments, it is apparent that the cited references fail to teach or suggest particles "having an average size of between 50 and 400 nm."

With respect to the Postle *et al.* reference, this reference appears to teach a photochromic assembly comprising photochromic glass beads in combination with a polymer latex. *See* Postle

*et al.*, Abstract. A person of ordinary skill would not seek to use particles "having an average size of between 50 and 400 nm" in view of the teachings of Postle *et al.* Postle *et al.* appears to teach away from Applicants' claimed invention by noting that "all the copolymer latexes prepared by the inventively used process have an average particle size ***of less than*** 0.05 μm [*i.e.*, less than 50 nm]." Postle *et al.*, col. 5, lines 49-51 (emphasis added); *see also Tec Air, Inc. v. Denso*, 192 F.3d 1353, 1360 (Fed. Cir. 1999) ("A reference may be said to teach away when a person of ordinary skill in the art would be ... led in a direction divergent from the path that was taken by the applicant ... ."). The data presented in Postle *et al.* supports this conclusion. Specifically, the data show that latexes having a particle size greater than 50 nm ***fail*** to work for their intended purpose. In this regard, Postle *et al.* states:

> However in the case of the sheet which comprises copolymer (5) [which includes particles having an average size of 92 nm] the milkiness of the coating ***precludes*** a noticeable darkening of the non-covered part of the sheet when exposed to the u.v.-lamp.

*Id.* at col. 6, lines 24-28 (emphasis added).

Also, Postle *et al.* does not appear to teach the additional elements recited in present claim 46—"wherein the particles of polymer material have a biphasic structure of the core skin type." The Action has provided no evidence that the particles disclosed in JP '471 would include the subject matter of claim 46. Applicants must request that an affidavit be prepared if the Action is relying on personal knowledge to support such an assertion. *See* 37 C.F.R. § 1.104(d)(2) and MPEP § 2144.03(C).

In view of the fact that the cited references fail to teach every element of the present invention, the present obviousness rejection cannot be maintained.

### 6. There Is No Motivation To Combine the Cited References

A necessary requirement in establishing a *prima facie* case of obviousness mandates a showing by the Action that there is a motivation to combine the teachings of JP '471 with the teachings of Postle *et al.* This has not been done.

As noted above, the JP '471 reference is directed towards a photochromic latex that includes a napthopyran compound. By contrast, the Postle *et al.* reference is directed towards a photochromic assembly comprising ***photochromic glass beads*** in combination with a polymer latex. *See* Postle *et al.*, Abstract. There is no suggestion or motivation in either of the cited references that the teachings could be combined. This is especially true where, as in the present case, the references are directed towards different compositions. For example, there does not appear to be any suggestion in Postle *et al.* that it teachings—which include the use of photochromic glass beads—could be used in combination with the disclosed JP '471 compositions that do not use glass beads. Similarly, there does not appear to be any suggestion that the compositions of JP '471 could be used in combination with the photochromic glass beads in Postle *et al.* Moreover, and as noted above, the Action has failed to present any evidence showing a motivation to combine these references.

Because there is no motivation to combine the cited references, the present obviousness rejection cannot be maintained.

### 7. There Is No Reasonable Expectation of Success That Such A Combination Would Work

A final element necessary to establish a *prima facie* case of obviousness requires a showing by the Action that there is a reasonable expectation that the combinations of the teachings would work. Similar to the other requirements, this has not been done.

Again, Postle *et al.* is directed towards compositions that comprise photochromic glass beads. By contrast, JP '471 is directed towards a photochromic latex that includes a napthopyran compound. There is no reasonable expectation of success that varying the size of the latex particles, as shown in Postle *et al.*, would work with the teachings of JP '471 would work. This is especially true in view of the data presented in Postle *et al.* which shows that a change in the size of the latex particles above 50 nm can render the photochromic assembly unusable. *See* Postle *et al.*, col. 6, lines 24-28 (emphasis added).

Because all three of the necessary elements required to establish a *prima facie* case of obviousness have not been established by the Action, the present obviousness rejection cannot be maintained. For at least the reasons stated above, the obviousness rejection for claims 42-54 should be withdrawn.

**E. The Double Patenting Rejection Is Improper**

The Action provisionally rejects claims 24-27, 36-39, 55-57, and 62 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of co-pending Application No. 09/991,773. The Action incorrectly contends that these claims are not patentably distinct from each other because the method of the claims use the same components as in the present invention.

Applicants traverse. Claims 24-27, 36-39, 55-57, and 62 are patentably distinct from the claims in the '773 Application.

The present claims are directed towards a "[a] method for preparing a latex with photochromic properties comprising: ***preparing an aqueous emulsion*** (I) of a composition A comprising ... and polymerizing composition A in the presence of a water-soluble initiator to obtain particles of an at least partially polymerized latex with photochromic properties." Claim 24 (emphasis added).

By contrast, the claims of the '773 Application are directed towards "[a] method of obtaining photochromic latex comprising: preparing a mixture comprising at least one organic monomer Z ... ***forming a miniemulsion of the mixture*** ... adding a polymerization primer to the mixture before, during, or after forming the miniemulsion; polymerizing of the reaction mixture, and recovering photochromic latex." Claim 13 of the '773 Application (emphasis added). Claim 30 of the '773 Application is directed towards "[a] photochromic latex prepared by a method comprising: preparing a mixture comprising at least one organic monomer Z ... ***forming a miniemulsion of the mixture*** ... adding a polymerization primer to the mixture before, during, or after forming the miniemulsion; polymerizing of the reaction mixture, and recovering photochromic latex." Claim 30 of the '773 Application (emphasis added).

The Action has not presented any evidence suggesting that the use of a miniemulsion is an obvious variation from using an emulsion and *vice versa*. In fact, the Action appears to base the present provisional double patenting rejection on the basis that the claims of the '773 application use the same components as the claims of the present application. *See* the Action, page 4. This is not the case; the present claims ***do not*** include an element of "forming a miniemulsion of the mixture." If the Action is relying on personal knowledge or any other reference to support its double patenting rejection, Applicants must request that the Examiner prepare an affidavit and enter it into the file history of this application pursuant to 37 C.F.R. § 1.104(d)(2); *see also* MPEP § 2144.03(C).

In contrast to the Action's lack of evidence, a person of ordinary skill in the art would not consider the present claims an obvious variation of the claims of the '773 patent. Conventional emulsions, for example, have larger initial particle sizes. For example, the sizes may be in the range of 1 to 10 $\mu$m (*i.e.*, 1,000 to 10,000 nm). By contrast, miniemulsions generally have

smaller initial particle sizes that may range, for example, from 50 to 500 nm. Additionally, when producing a latex from an emulsion, the initial particle sizes dissolve and then reorganize into the latex. By contrast, the initial particles in a miniemulsion process typically do not dissolve prior to reorganizing into the latex. These differences provide strong evidence that the present claims are ***not*** an obvious variation of the claims of the '773 application and *vice versa*.

Based on the present claims, Applicants' proffered evidence, and the Action's lack of evidence to support the double-patenting rejection, the present rejection cannot be maintained. The provisional double patenting rejection of claims 28-35, 37, 38, 40, 41, 58-61, and 63-66 in view of the '773 Application should therefore be withdrawn.

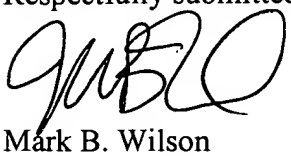
**F. Conclusion**

Applicants believe that the present document is a full and complete response to the Office Action dated January 7, 2004. In conclusion, Applicants submit that, in light of the foregoing remarks, the present case is in condition for allowance, and such favorable action is respectfully requested.

It is believed that no fee is due; however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to this document, consider this paragraph such a request and authorization to withdraw the appropriate fee from Fulbright & Jaworski Deposit Account No. 50-1212/ESSR:052US.

The Examiner is invited to contact the undersigned Attorney at (512) 536-3035 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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